



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/587,418

07/27/2006

Jochen Moench

3775

7301

7590
Striker Striker & Stenby
103 East Neck Road
Huntington, NY 11743

12/31/2008

EXAMINER

MACARTHUR, VICTOR L

ART UNIT

PAPER NUMBER

3679

MAIL DATE

DELIVERY MODE

12/31/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/587,418	Applicant(s) MOENCH ET AL.	
	Examiner VICTOR MACARTHUR	Art Unit 3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 July 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

The drawings were received on 11/17/2008. These drawings are **NOT** acceptable since they contain new matter. Specifically, the dimensions for element 15 as newly added to figure 2 (i.e., having a top to bottom length approximately 12 times that of the left to right width) does not have antecedent basis in the original disclosure. Note that the drawings filed 11/17/2008 would have also been objected to as follows (if they did not include new matter):

- Erasures, alterations, overwriting, interlineations, not accepted. See 37 CFR 1.84(c).
- Margins not properly sized as 2.5cm (top), 2.5cm (left), 1.5cm (right), 1.0cm (bottom). See 37 CFR 1.84(g).
- Separate views of figure 2 not labeled separately or properly. See 37 CFR 1.84(h).
- The lines, numbers & letters not uniformly thick and well defined, clean, durable, and black (poor line quality). See 37 CFR 1.84(l).
- The drawings are objected to under 37 CFR 1.84(h)(5) because Figure 2 show(s) modified forms of construction in the same view.

The drawings filed 7/27/2006 are objected to as follows:

- The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the limitation “wherein said width dimension in said predetermined direction (Y) is smaller than

Art Unit: 3679

said axial dimension and said radial dimension (Z)” (claim 1) must be shown or the feature(s) canceled from the claim(s). Note that currently, figures 1 and 2 show separate embodiments viewed from a common position that does not reveal the width in the direction (Y). Since it appears that this limitation cannot be shown without the addition of new matter (see above) this limitation must be removed from the claims and/or pursued in a Continuation in Part application that includes drawings fully showing the limitation. No new matter may be entered in this application.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Corrected drawing sheets in compliance with 37 CFR 1.84 and 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be

Art Unit: 3679

labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

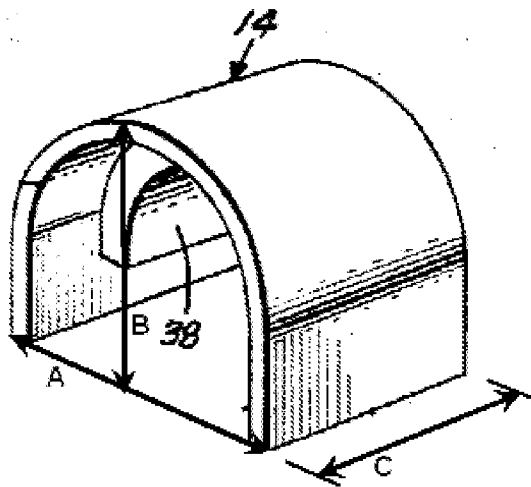
Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Zagorski (U.S. Patent 3,401,282) (see marked-up figure below).



Claim 1. Zagorski discloses (Figs.1-6) all of the claimed connecting device structure as follows: a connecting device, comprising: at least one connecting element (14) having an axial

Art Unit: 3679

dimension (A) in a direction of an axis (axis of 118), a radial dimension (B) perpendicular to said axis, and a width dimension (C) perpendicular to said axial and said radial dimensions, wherein said width dimension is smaller than said axial dimension and said radial dimension

Furthermore:

- Note applicant's statement that "only the connection device is intended to be claimed, NOT a combination of the connecting device with the various elements to be connected" (lines 17-18 of page 9 of the Remarks filed 12/17/2007). That is to say that the only claimed structure is that shown in figure 2 of applicant's drawings.
- The claim is drawn to "A connecting device" not a positive combination of --An assembly comprising a motor and transmission connected by a connecting device--. As detailed above, the prior art "connecting device" structure is substantially identical to the claimed structure and thus equally "configured" to perform the claimed intended functional usage with an engine and transmission. These claimed properties or functions are presumed to be inherent, thus presenting a *prima facie* case (*In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 [CCPA 1977]) and properly shifting the burden of submitting evidence proving otherwise to the applicant (*In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 [Fed.Cir. 1990]) in accordance with MPEP §2112.01 (I). If applicant truly wishes to limit the scope of the claim to positively require an engine and transmission then the combination must be positively recited (e.g., --An assembly comprising a motor and transmission connected by a connecting device--). A connecting device merely "configured" to connect an engine and transmission does not actually require an engine or transmission, but merely the

Art Unit: 3679

- capability to use as such. As detailed above this capability is presumed to be present in the prior art connecting device until applicant proves otherwise with evidence.
- Mere allegation that the prior art is incapable of performing the claimed function, in a declaration or otherwise, is not considered proper evidence much less proof (*In re Schreiber*, 128 F.3d 1473, 1478 44 USPQ2d 1429, 1432 [Fed.Cir.1997]).
 - Anticipation of the **claimed structure** automatically results in the assumption of the function to be inherent and further automatically shifts the burden to address functional limitations to the applicant regardless of whether or not the examiner specifically addresses the functional limitations. This is necessary since the Patent Office is unable to obtain, test or compare prior art products. See *Ex parte Martin et al*, decision of the Board of Patent Appeals and Interferences, Patent No. 6,920,019, the paper filed on 11/19/2004, pages 6 and 9. Note that citation of an unpublished decision of the Board of Patent Appeals and Interferences is proper when it is available to the public in the patented file, in accordance with MPEP §707.06. Further note that the examiner is "required or authorized" to adhere to such prior decisions in accordance with the Forward and Introduction section of the MPEP.

Claim 2. Zagorski discloses the connecting device as recited in claim 1. Furthermore:

- The prior art at least one connecting element is fully capable of being substantially rigid (in that it is metal) in a direction (Z) radial to an axis of a motor shaft.

Art Unit: 3679

Claim 3. Zagorski discloses the at least one connecting device as recited in claim 1, wherein the connecting element is substantially (when compared to ceramics) elastically deformable (in that the prior art is metal).

- The prior art connecting element is fully capable of performing the intended use of being embodied such that it is orientated with respect to a motor shaft substantially deformable in a direction axial to an axis of a motor shaft.

Claim 4. Zagorski discloses the at least one connecting device as recited in claim 1.

Furthermore:

- The prior art connecting element is fully capable of performing the intended use of being configured to connect a motor housing to a transmission housing, spaced axially apart from it.

Claim 5. Zagorski discloses the connecting device as recited in claim 1, wherein the connecting element is U-shaped.

Claim 6. Zagorski discloses the connecting device as recited in claim 5, wherein the connecting element has a first leg (left leg of 14) and second leg (right leg of 14) that are connected to each other by a bridge piece (top bridge portion of 14).

Claim 7. Zagorski discloses the connecting device as recited in claim 6, wherein it is **possible** (though not necessary) to connect the connecting element to a motor housing in a region of an end surface of the first leg.

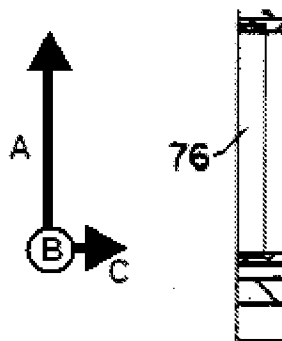
Claim 8. Zagorski discloses the connecting device as recited in claim 6, wherein it is **possible** (though not necessary) to connect the connecting element to a transmission housing in a region of an end surface of the second leg.

Art Unit: 3679

Claim 9. Zagorski discloses the connecting device as recited in claim 6, wherein the connecting element has a recess (recess in 14 receiving 38) and in the region of the recess, the connecting element is substantially concave.

Claim 10. Zagorski discloses the connecting device as recited in claim 9, wherein the recess has an **approximately** (but not necessarily exactly) ellipsoidal form (in that the recess is a non-circular curve similar to a portion of an ellipse).

Claims 1, 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Henderson (U.S. Patent 5,237,871).



Marked-up figure 6

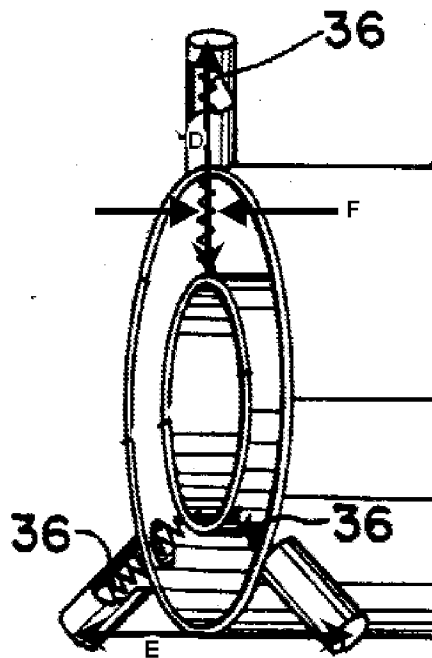
Claims 1 and 11. Henderson discloses (figs.1-6, see marked-up figure 6 above) **all of the claimed connecting device structure as follows:** a connecting device, comprising: at least one connecting element (plastic rings 76 and 78 described in col.7, ll.60-63) having an axial dimension (dimension of 76 along A) in a direction of an axis (A), a radial dimension (dimension of 76 along C) perpendicular to said axis, and a width dimension (dimension of 76 along B) perpendicular to said axial and said radial dimensions, wherein said width dimension is smaller

Art Unit: 3679

than said axial dimension and said radial dimension; and the connecting element is at least partially comprised of an elastic plastic (plastic rings of col.7, ll.60-63). Note that all plastics inherently have some degree of elasticity. Furthermore:

- Note applicant's statement that "only the connection device is intended to be claimed, NOT a combination of the connecting device with the various elements to be connected" (lines 17-18 of page 9 of the Remarks filed 12/17/2007). That is to say that the only claimed structure is that shown in figure 2 of applicant's drawings.
- As detailed above, the prior art "connection device" structure is substantially identical to the claimed structure such that claimed properties or functions are presumed to be inherent, thus presenting a *prima facie* case (*In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 [CCPA 1977]) and properly shifting the burden of submitting evidence proving otherwise to the applicant (*In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 [Fed.Cir. 1990]) in accordance with MPEP §2112.01 (I).
- Mere allegation that the prior art is incapable of performing the claimed function, in a declaration or otherwise, is not considered proper evidence much less proof (*In re Schreiber*, 128 F.3d 1473, 1478 44 USPQ2d 1429, 1432 [Fed.Cir.1997]).
- See also *Ex parte Martin et al*, decision of the Board of Patent Appeals and Interferences, Patent No. 6920019, the paper filed on 11/19/2004, pages 6 and 9. Note that citation of an unpublished decision of Board of Patent Appeals and Interferences is proper when it is available to the public in the patented file, in accordance with MPEP §707.06.

Art Unit: 3679



Marked-up figure 1

Claims 1 and 12. Henderson discloses (figs.1-6, see marked-up figure above) **all of the claimed connecting device structure as follows:** a connecting device, comprising: at least one connecting element (visco elastic coated springs 36 described in col.2, ll.25-35) having an axial dimension (D) in a direction of an axis (axis extending along D), a radial dimension (E) perpendicular to said axis, and a width dimension (F) perpendicular to said axial and said radial dimensions, wherein said width dimension is smaller than said axial dimension and said radial dimension; and the connecting element is at least partially coated with a viscoelastic material (visco elastic coated springs of col.2, ll.25-35). Furthermore:

- Note applicant's statement that "only the connection device is intended to be claimed, NOT a combination of the connecting device with the various elements to be connected" (lines 17-18 of page 9 of the Remarks filed 12/17/2007). That is to say that the only claimed structure is that shown in figure 2 of applicant's drawings.

Art Unit: 3679

- As detailed above, the prior art “connection device” structure is substantially identical to the claimed structure such that claimed properties or functions are presumed to be inherent, thus presenting a *prima facie* case (*In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 [CCPA 1977]) and properly shifting the burden of submitting evidence proving otherwise to the applicant (*In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 [Fed.Cir. 1990]) in accordance with MPEP §2112.01 (I).
- Mere allegation that the prior art is incapable of performing the claimed function, in a declaration or otherwise, is not considered proper evidence much less proof (*In re Schreiber*, 128 F.3d 1473, 1478 44 USPQ2d 1429, 1432 [Fed.Cir.1997]).
- See also *Ex parte Martin et al*, decision of the Board of Patent Appeals and Interferences, Patent No. 6920019, the paper filed on 11/19/2004, pages 6 and 9. Note that citation of an unpublished decision of Board of Patent Appeals and Interferences is proper when it is available to the public in the patented file, in accordance with MPEP §707.06.

Response to Arguments

Applicant's arguments with regard to the claim rejections have been fully considered but they are not persuasive.

All of applicant's claimed limitations are met by the prior art within the broadest reasonable interpretation of the claim language. Subject matter that is not recited in the claims cannot be relied upon to persuasively argue for allowability. Claimed limitations cannot be persuasively argued to have a scope narrower than that, which is reasonably most broad. In a

Art Unit: 3679

product claim, intended use, labeling and functional language cannot overcome the prior art wherein the prior art discloses structure fully capable of performing such uses and functionality. Capability need not be expressly stated in the prior art wherein it is inherent to the structure. Such inherency of functional capability is presumed to be present in the prior art structure until applicant proves otherwise with submission of actual evidence, in accordance with MPEP 2112.01(I).

The applicant argues that the prior art does not disclose the limitations involving the motor housing, motor, transmission housing and transmission. This is not persuasive. As detailed above, the applicant is claiming a “connecting device” that is merely intended to be used with these elements, not a connecting device used in combination with these elements, such that patentability must be obtained based upon the device itself rather than elements merely intended to be used therewith. Note also applicant’s statement that “only the connection device is intended to be claimed, NOT a combination of the connecting device with the various elements to be connected” (lines 17-18 of page 9 of the Remarks filed 12/17/2007). Prior art need only present structure capable of performing applicant's intended use limitations. The prior art need not specifically describe the intended use or functional limitations, nor specifically describe the capability to perform as such where such capability is inherent to the prior art structure. Inherency of capability to perform intended use and functional limitations is automatically presumed in prior art that sets forth all of applicant's **claimed** structure until the applicant proves otherwise. See MPEP 2112.01.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor MacArthur whose telephone number is (571) 272-7085. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Art Unit: 3679

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

January 1, 2009

/Victor MacArthur/
Primary Examiner, Art Unit 3679